

Application No. 10/673,810
Amendment dated April 17, 2009
Reply to Office Action of December 23, 2008

REMARKS

In the above-mentioned Office Action, all of the pending claims, claims 1, 2, 4, 8, 9, 11, and 15-18, were rejected. The claims were rejected under Section 103(a) over the new combination of Rune, Sarkkinen, and Sharma.

Responsive to the rejection of the claims, independent claims 1, 8, and 16 have been amended, as set forth herein, in manners believed better to distinguish the invention of the present application over the cited combination of references.

With respect to exemplary claim 1, the claim has been amended, now to state that one of a cell update confirm message, a universal mobile telecommunication system terrestrial access network registration area, an update confirm message, and a radio resource control connection setup message is received. The claim is further amended to state that any record of a cell identifier that temporarily identifies a cell is cleared from the UE and that, if the received message includes a new cell identifier, that the cell identifier is not stored in the UE. The claim has further been amended, now to recite the moving to a dedicated channel state and of optionally sending a response message after the UE is cleared of any record of a cell identifier. Claims 8 and 16 have been analogously amended.

Support for the amended recitations is found in the disclosure, e.g., on page 6, line 27 – page 7, line 2; page 7, line 22 page 8, line 4; page 8, line 22 –page 9, line 5; page 9, lines 22-26; page 10, lines 1-14; and page 10, line 22 – page 11, line 9.

As now-presented, the independent claims are believed to be distinguishable over the cited combination of references, for reasons which follow.

Additionally, the Applicants assert that Sharma, having an earliest-possible effective date of July 11, 2003, is not a proper reference to be used against the present application. Enclosed herewith, under separate title, is an affidavit, submitted pursuant to 37 C.F.R. 1.131,

Application No. 10/673,810
Amendment dated April 17, 2009
Reply to Office Action of December 23, 2008

by Co-Inventor Andrew Farnsworth is which facts are asserted to evidence prior invention, prior to the earliest-possible effective date of Sharma.

And, further, the Applicants also assert that the effective date of Sharma, for purposes of the Examiner's reliance on the reference against the claims, is not the filing date of its provisional application but, rather, the filing date of the utility application in 2004, after the filing date of the present application.

In the rejection of the claims, the Examiner acknowledged that Rune does not disclose optionally sending a response message receivable by a network after a UE is cleared of any record of a cell identifier. The Examiner, however, relied upon Sarkkinen for showing such feature. The Examiner additionally acknowledged that neither Rune nor Sarkkinen disclose, in response to a message, clearing from a device any record of a cell identifier before moving to the dedicated channel state. But, the Examiner relied upon Sharma for showing this feature.

The Applicants specifically traverse the Examiner's reliance upon Sharma. As noted above, the Applicants believe Sharma to an improper reference to be used against the present application. Additionally, in the rejection of the claims, the Examiner relied upon paragraphs [0011] – [0019], [0064] – [0069], [0072], and [0101] – [0106] of Sharma. However, these paragraphs only appear in the utility application, filed on June 28, 2004, not in the provisional application, serial number 60/486,584, filed on July 11, 2003, and upon which Sharma claims priority. That is to say, the provisional application fails to disclose the sections of Sharma upon which the Examiner places reliance. And, Figure 6b, described in paragraphs [0101] – [0106] does not appear in the provisional application. Therefore, irrespective of what Sharma discloses in the relied-upon sections of the disclosure, such sections are believed to be entitled to the June 28, 2004 filing date of the utility application and not that of the earlier-filed, provisional application.

Application No. 10/673,810
Amendment dated April 17, 2009
Reply to Office Action of December 23, 2008

Additionally, the Applicants further traverse the Examiner's reliance upon Rune for showing the clearing from the UE of any record of a cell identifier, as now-recited in the amended claims. Specifically, the Applicants traverse the Examiner's reliance upon paragraphs [0004] – [0008], [0023] – [0027], [0036] – [0038], and [0063] – [0069] for showing this feature. While paragraphs [0067] and [0068] of Rune make reference to movement of a user equipment between cells, there does not appear to be any disclosure of the clearing of a record of a cell identifier, as now-presented in the claims.

The remaining dependent claims, which include all of the limitations of their respective parent claims, are believed to be patentably distinguishable over the cited combination for the reasons as those, just-given, with respect to their respective parent claims.

Accordingly, in light of the foregoing, independent claims 1, 8, and 16, as now-presented, and the remaining dependent claims dependent thereon, are believed to be in condition for allowance. Reexamination and reconsideration for allowance of the claims is respectfully requested. Such early action is earnestly solicited.

Respectfully submitted,

/ Robert H. Kelly/

Robert H. Kelly
Registration No. 33,922

KELLY & KRAUSE, L.P.
6600 LBJ Freeway, Suite 275
Dallas, Texas 75240
Telephone: (214) 446-6684
Fax: (214) 446-6692
robert.kelly@kelly-krause.com